

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Clarke

Group Art Unit 1761

Serial No.: 09/858,190

Examiner Weinstein, Stephen L.

Filing Date: May 15, 2001

Title: Packaging of Bananas

Mail Stop Issue Fee

Office of Patent Legal Administration

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT**

Sir,

This paper is an application for patent term adjustment under 37 CFR 1.705.

(1) The fee set forth in 37 CFR 1.18 (e) accompanies this paper.

(2) Statement of the Facts Involved.

(2) (i). The correct Patent Term Adjustment is 864 days, not the 332 days set out in the Determination of Patent Term Adjustment mailed 11/26/2010. As will be clear from the facts set out below, in the period of time between 12/11/2007 and 09/02/2008, the 266 days attributed to Applicant's delay (on 09/02/2008 In the Determination of Patent Term Adjustment) should in fact be attributed to delay by the Office. Thus, the period of 332 days should be increased by twice the 266 days.

(2) (ii) The relevant dates as specified in 37 CFR 1.703 (a) through (e) and the associated facts are as follows.

(a) On 12/11/2007 (December 11, 2007)

Applicant filed a Reply to the Office Action mailed 12/28/2006.

[By way of explanation of what might otherwise appear to be a failure to file a Reply within six months of the date of the Office Action mailed 12/11/2007, it is noted that

on 05/29/2007, a Reply to the Office Action mailed 12/28/2006 was filed by facsimile,

on 09/05/2007, the Examiner issued a Notice of Informal Amendment stating that the Reply to the Office Action mailed 12/28/2006 was non-responsive, since the amendment was not legible in portions of every page and requesting applicant to resubmit a legible copy of the amendment within 1 month,

on 09/24/07, Applicant filed a legible copy of the Reply to the Office Action filed 12/28/2006,

on 12/04/07, the Examiner issued a Notice of Non-Compliant Amendment on the ground that the amendment filed on 09/24/07 was not signed, and setting a term of one month for response,

on 12/11/07, Applicant filed a signed and legible copy of the Reply originally filed by facsimile on 5/29/2007.]

(b) On 07/03/2008, the Examiner mailed a Office Action stating that the reply filed on 12/11/2007 was not fully responsive because "it does not appear that applicant has addressed the references that were newly applied in the office action mailed 12/28/2006", and setting a term of 1 month for response.

(c) As made of record by the paper entitled Record of Telephone Conversation mailed 08/28/2008 (docketed on 09/02/2008 as Miscellaneous Incoming Letter), there was a telephone conversation on 08/28/2008, between the Examiner and the responsible patent agent, THP Richardson, in which the Examiner agreed to withdraw the Office Action mailed 07/03/2008, and to issue a new Office Action which would, inter alia, fully identify any of the "newly added" references on which the Examiner wish to rely (Applicant having previously noted, on page 7 of the 05/29/2007 Reply to the Office Action mailed 12/28/2006,

that it had not been possible to identify the "newly added" references in question).

(d) On 09/02/2008, the Examiner mailed a Office Action again stating that the Reply filed on 12/11/2007 was not fully responsive. The text of that Office Action is identical to the text of the Office Action mailed 07/03/2008.

(e) As made of record by the paper entitled Record Telephone Conversation transmitted by facsimile on 09/30/2008, there was a telephone conversation on or about 09/03/2008 between the Examiner and THP Richardson, in which the Examiner agreed that the Office Action mailed 09/02/2008 had been sent in error and agreed that the duplicate Office Action did not require a response.

(f) As made of record by the paper entitled Record of Telephone Conversation transmitted by facsimile on 12/05/2008, there was a telephone conversation on or about 11/18/2008 between the Examiner and THP Richardson, in which the Examiner confirmed that the application was awaiting action by the Office.

(g) On 03/26/09, Applicant filed a communication inquiring as to when further action might be expected, and noting that the Examiner had previously indicated that the application was awaiting further action by the Office.

(h) On 04/23/2010, the Examiner issued a new Office Action.

The period of time between 04/11/2008 (4 months after the filing of the reply mailed 12/11/2007) and 04/23/2010 (when the Examiner issued a correct Office Action) amounts to 742 days (see the table below). Applicant submits that all of those days should be included in the period of adjustment of patent term due to examination delay under 37 CFR 1.703, together with other examination delays.

Period of time	Number of days
04/11/2008-04/11/2010	731 (2008 being a leap year)
04/12/2010-04/22/2010	11

The Patent Term Adjustment entries on the PAIR site for the period of time between 12/11/2007 and 04/23/2010 attribute 266 days to delay by Applicant and 476 days to

delay by the Office (a total, as above, of 742 days). That erroneous attribution is apparently due to the incorrect entry #72, which states that on 09/02/2008, Applicant filed a Response after Non-Final Action. In fact, as noted above, and as stated by entry #66, the paper filed 09/02/2008 was a "Miscellaneous Incoming Letter", namely a Record of Telephone Conversation in which the Examiner agreed that the Office Action mailed 09/02/2008 had been sent in error and that the Office Action did not require a response.

### **CONCLUSION**

It is believed that, having regard to the facts and arguments set out above, The Patent Term Adjustment for this application should be 864 days.

The USPTO is invited to contact me at (408) 489-2591 for a discussion on the matter if needed.

Please charge the \$200 fee under § 1.18(e) to our PTO deposit account number: 50-2396. It is not believed that the \$400 fee under § 1.18(f) is required since the apportionment of the 266 days was incorrect *ab initio*, as opposed to requesting a restatement of the term reduced pursuant to § 1.704(b), however, if it is determined that this fee is required, please charge our PTO deposit account number 50-2396. Any additional fees that may be required to maintain pendency of the present application, or apply any credits to our PTO deposit account number: 50-2396.

Respectfully submitted,

Dated: February 24, 2011

By: /James S. McDonald/  
James S. McDonald, Reg. No. 44,229

On behalf of Apio, Inc.  
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